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Paper No. 16

BANNER & WITCOFF
1001 G STREET, N.W.
SUITE 1100
WASHINGTON, DC 20001

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DEC 26 2001

OFFICE OF PETITIONS

In re Application of :
Mazhar, Nadalin, Larkin, Warne :
Application No. 09/411,171 : DECISION REFUSING
Filed: October 1, 1999 : STATUS UNDER 37 CFR
Attorney Docket No. 3797.80030 : 1.47(a)
For: Windows Radio Toolbar :
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This is in response to the request for reconsideration of petition under 37 CFR 1.47(a), and the petition under 37 CFR 1.183, filed August 17, 2001.

The petition under 37 CFR 1.47 is dismissed.

The petition under 37 CFR 1.183 is denied

Request For Reconsideration of Petition Under 37 CFR 1.47(a):

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented

with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee; and

(4) a statement of the last known address of the non-signing inventor.

Applicant lacks item (2), as set forth above.

As to item (2), An oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. The previously submitted declaration does not set forth Kevin Warne's citizenship. An oath or declaration in compliance with 37 CFR 1.63 and 1.64 is REQUIRED. See MPEP 409.03(a).

Petition under 37 CFR 1.183:

37 CFR 1.183, Suspension of Rules, states (in part):

"In an extraordinary situation, when justice requires, any requirement of the regulation in this part which is not a requirement of the statute may be suspended or waived by the Commissioner or the Commissioner's designees..."

Though petitioner, as stated in the instant petition, believes that a patent application filing under 35 USC 118 and 37 CFR 1.47 is exempt from the statutory requirements of 35 USC 115, the Patent and Trademark Office does not share petitioner's views. As stated in MPEP 602.03, "requirements of the statute, e.g., that the applicant state his or her citizenship...cannot be waived."

Accordingly, the Office views the requirement that the citizenship of an inventor be provided on the declaration as a requirement established by statute and it cannot be suspended or waived. See 35 USC 115. Therefore, this information must be provided in order to submit a declaration in compliance with 35 USC 115 and 116, and 37 CFR 1.63 and 1.64.

Please note, if applicable, "The statute (35 USC 115) requires an applicant, in a nonprovisional application, to state his or her citizenship. Where the applicant is not a citizen of any country, a statement to this

effect is accepted as satisfying the statutory requirement..." MPEP 605.01

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
 Box DAC
 Washington, DC 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Office of Petitions
 2201 South Clark Place
 Crystal Plaza 4, Suite 3C23
 Arlington, VA

Telephone inquiries related to this decision should be directed to Petitions Attorney Edward Tannouse at (703) 306-9200.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy